



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,948	08/22/2003	Tsuyoshi Nakashima	80329-0015	8249

23353 7590 12/07/2004

RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER

TADESSE, YEWEBDAR T

ART UNIT	PAPER NUMBER
----------	--------------

1734

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,948

Applicant(s)

NAKASHIMA ET AL.

Examiner

Yewebdar T Tadesse

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/10/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 18, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 23-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08/22/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

1. Applicant's election with traverse of II in the reply filed on 11/10/2004 is acknowledged. The traversal is on the ground(s) that a thorough search of the subject matter of any one group of claims would necessarily encompass a search for the subject matter of the remaining claims. This is not found persuasive because as shown in paragraph 2 of the Election/Restriction requirement mailed on 10/18/2004, the inventions are distinct because the apparatus can be used to coat the interior surface of *any cylinder*. As such, the non-elected and elected inventions are patentably distinct invention whose examination together would place an undue burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/10/2004.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

Art Unit: 1734

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogstrom (US 3,797,456) in view of A. A. Arvintz et al (US 2,565,543). Hogstrom discloses (see Figs 1-2 and 7) an apparatus for forming a coat on an inner surface of a hollow body (capable of coating bearing) having a cylinder shape, comprising a rotating means (R) for rotating the hollow body in its circumferential direction; an applying means consisting of a nozzle (12 and 13) for applying a coating material for forming the coat on the inner surface of the hollow body and the applying means injecting the coating material by airless spray painting (see Abstract). Hogstrom lacks teaching a coating material supplying means for supplying the coating material by applying pressure to the coating material in a sealed state and circulating the coating material. However, a coating material supply means applying pressure to the coating material in a

Art Unit: 1734

sealed chamber and circulating the coating material is well known in the art; for instance –Arvintz et al discloses (see Fig 1 and column 2-3, lines 46-60 and 1-3) a coating material dispensing device applying pressure to the coating material in a sealed state and circulating the coating material to and from the gun 45. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a coating material supply means shown by Arvintz in Hogstrom device to deliver coating material to the nozzles without congestion of the coating material within the system.

6. Claims 17-18 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shriver et al (US 4,606,942) in view of A. A. Arvintz et al (US 2,565,543), Horvath et al (US 3,816,165) and Mitsuji et al (US 6,060,554).

Shriver et al discloses (see Fig 1) an apparatus for forming a coat on an inner surface of plastic bottle (capable of coating plastic bearing) having a cylinder shape, comprising a rotating means (bottle rotating motor 50) for rotating the bottle in its circumferential direction; an applying means consisting of a nozzle (60) for applying a coating material for forming the coat on the inner surface of the bottle and the applying means injecting the coating material; and a coating material supplying means (41, 35) with a coating material pumping means.

Hogstrom lacks teaching an airless spray painting and a coating material supplying means applying pressure to the coating material in a sealed state and circulating the coating material. However, coating material supply means applying pressure to the coating material in a sealed chamber and circulating the

Art Unit: 1734

coating material is well known in the art; for instance –Arvintz et al discloses (see Fig 1 and column 2-3, lines 46-60 and 1-3) a coating material dispensing device applying pressure to the coating material in a sealed state and circulating the coating material to and from the gun 45. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a coating material supply means shown by Arvintz in Shriver et al's device to deliver coating material to the nozzles without congestion of the coating material within the system. As to the air-less painting, it is well known in the art to use airless or air sprayer to a plastic or metallic substrate as shown by Mitsuji (see column 7, lines 41-64). Horvath et al also uses (see Abstract) an airless sprayer in applying coatings to the interior of cans. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an airless spray painting means in Shriver et al to minimize overspray and the quantity of material required (see Horvath et al, column 7, lines 60-68)

As to claim 18, in Shriver et al the nozzle (60) is adapted to be inserted into an inner side of the bottle to inject the coating material from the inner side of the bottle (see Figs 1 and 10-17).

With respect to claims 21-22, Shriver et al discloses a nozzle (60) that can be reciprocated along an axial direction of the bottle (see column 3, lines 47-62).

Allowable Subject Matter

7. Claims 23-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: prior art of record does not disclose or suggest an apparatus for forming a coat on an inner surface of a bearing comprising, among others, a rotating means comprising a first and a second jig and a rotor, wherein the first jig having a semi-cylinder surface for receiving a bearing and a second jig also having a semi-cylinder shape with outer diameter larger than the first jig and attached to a rotor while holding the bearing between the first and second jigs.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yewebdar T Tadesse whose telephone number is (571) 272-1238. The examiner can normally be reached on Monday-Friday 8:00 AM-4: 30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



YTT


CHRIS FIORILLA
SUPERVISORY PATENT EXAMINER
Au 1734